

REMARKS

Claims

Applicant has amended independent claim 1 to include language stating that the display in the portable apparatus “is operable to display images of the digital content subsequent to downloading and storing the digital content” and “the display is operable to render the digital content using a browser regardless of whether the portable apparatus is coupled to the data communication network”. The quoted language finds support in the disclosure at p. 12, l. 23 to p. 13, l. 19 of the specification, among other places. Applicant has added language similar to the quoted language to independent claim 12.

Applicant has amended dependent claim 7 to include language stating that the display in the portable apparatus is “is operable to increase a size of a client window for the browser”. The quoted language finds support in the disclosure at p. 37, l. 14 to p. 38, l. 5 of the specification, among other places.

Applicant has also amended independent claim 14 to include language stating that “the stored content bundles are displayed using a browser on a peripheral browsing device coupled to the portable non-volatile storage”. This language finds support in the disclosure at p. 12, l. 23 to p. 13, l. 19 of the specification, among other places.

Additionally, Applicant has made technical amendments to claims 1, 6, and 8-11.

Applicant has added a new independent claim 16 and claims 17-21, which depend from claim 16.

Applicant has canceled independent claim 13 without prejudice. Consequently, claims 1-12 and 14-21 remain pending in the prosecution.

Drawings

The Examiner has stated that: “Formal Drawings are required to be submitted by the applicant.” Applicants believe that they submitted such documents as replacement drawings on July 6, 2001, as can be verified by viewing the Image File Wrapper (IFW) file in private PAIR.

Rejections Based on Obviousness

The Examiner has rejected claims 1-12 under 35 U.S.C. 103(a), as allegedly being obvious over U.S. Patent Application No. 6,321,231 to Jebens et al. (hereafter “Jebens”) in view of Miller. The Examiner has provided no patent number or other identification for Miller. So Applicant is interpreting the reference to Miller as an oversight and assumes that the Examiner meant to refer to U.S. Patent No. 6,671,757 to Multer et al. (hereafter “Multer”), which the Examiner has previously cited.

When an obviousness rejection is made on the basis of an alleged combination of prior art elements according to known methods to yield predictable results, an examiner must find that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. See MPEP 2143(A). Applicant believes that such a finding cannot be made with respect to the rejected claims.

As noted above, independent claim 1 now includes language stating that the display in the portable apparatus “is operable to display images of the digital content subsequent to downloading and storing the digital content” and “the display is operable to render the digital content using a browser regardless of whether the portable apparatus is coupled to the data

communication network”. To meet similar language previously presented in claim 1, the Examiner cited Jebens at column 5, lines 2-23, which read *in toto* as follows:

In order to provide easy access to those images and to efficiently utilize its in-house computer storage facilities, that corporation can save these digital assets on the data management system. If, on occasion, the corporation wishes an advertizing agency to create a publication, such as a brochure or web page, incorporating one or more of those digital images, the corporation need only provide the agency with access to the system.

Once given permission and provided with suitable password information, the advertizing agency could then access the system; search the database of the corporation's digital images; and **download low resolution copies of images to be used in the publication. The agency would then disconnect or logoff from the system and begin its efforts to create a document incorporating the downloaded images.** Upon completion of that process, the agency would re-connect to the system to request that the system electronically route the created document with high resolution copies of the selected digital images to a publishing entity such as a printer, where the finalized brochure would be published. (emphasis added)

Ostensibly, this language from Jebens does not expressly teach using a browser on a portable apparatus to display stored digital content when the portable apparatus is not coupled to a data communication network. The term “browser” is nowhere mentioned here.

Nor does this language inherently teach such an offline use of a browser. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted), as quoted in MPEP 2112. The language from Jebens emphasized above is wholly consistent with an arrangement where images are downloaded through the use of an

application program such as a browser, but then displayed using an application program such as an image editor. In this regard, see Jebens at column 20, line 18, to column 21, line 15. Yet such an arrangement is not what the Applicant has described in amended independent claim 1. Claims 2-11 are allowable by virtue of their dependency on claim 1.

Additionally, the Examiner cites Jebens at column 5, lines 2-35, to meet the features of dependent claim 5. The Examiner seems to be unaware of the last amendment to claim 5, which specifies that “the non-volatile storage medium is flash memory.” In any event, Jebens does not expressly or inherently teach flash memory in the cited lines.

The Examiner also cites Jebens at column 5, lines 2-55 to teach the features of dependent claim 6. The Examiner seems to be unaware of the last amendment to claim 6, which specifies that the “apparatus further comprises a touch screen to receive user input.” Again, Jebens does not expressly or inherently teach a touch screen in the cited lines.

The Examiner cites the same section of Jebens for dependent claim 7, which was amended to state that the portable apparatus is “is operable to increase a size of a client window for the browser”. But as noted above, Jebens does not expressly or inherently teach the offline use of a browser, let alone a display with a client window for the browser.

Independent claim 12 now includes language stating that stored “digital content is displayed using a browser executing on the portable apparatus regardless of whether the portable apparatus is coupled to the data communication network”. Applicants’ argument

above with respect to claim 1 applies with equal force to this language in independent claim 12.

Claims 14 and 15 were rejected under 35 U.S.C. 103(a), as allegedly being obvious over Jebens in view of Multer and U.S. Patent No. 6,170,074 to Kondo et al. (hereafter “Kondo”). Independent claim 14 now includes language stating that “the stored content bundles are displayed using a browser on a peripheral browsing device coupled to the portable non-volatile storage”. Applicants’ argument above with respect to claim 1 also applies with equal force to this language in independent claim 14. Claim 15 is allowable by virtue of its dependency from claim 14.

Finally in this regard, new independent claim 16 includes language stating that “stored content bundles are displayed using a browser on a peripheral browsing device”. Applicants’ argument above with respect to claim 1 also applies with equal force to this language in independent claim 16, as well as dependent claims 17-21.

Consequently, Applicant believes that the combination of references cited by the Examiner does not teach each of the elements of claims 1-12, 14-15, and 16-21 and therefore does not render those claims obvious.

Conclusion

Based on the foregoing, Applicant believes that each of the claims is now allowable and requests a notice allowing them. If the Examiner has any questions concerning the present response, the Examiner is requested to contact the undersigned at the telephone number set forth below.

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